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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/905,574	07/12/2001	Paul G. Glucina	HR1.P03	4225

7590

05/21/2002

Michelle Bos
Stratton Ballew PLLC
213 South 12th Avenue
Yakima, WA 98902

EXAMINER

MCCORMICK, SUSAN B

ART UNIT

PAPER NUMBER

1661

DATE MAILED: 05/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/905,574

Applicant(s)

GLUCINA ET AL.

Examiner

Susan B. McCormick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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Detailed Action

Drawings

The drawings have been approved by an official draftsman.

Objection to the Disclosure

37 CFR 1.163

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

In plant applications filed under 35 U.S.C. 161, the requirements of 35 U.S.C. are limited. The following is a quotation of 35 U.S.C. 162:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 37 CFR 1.163 (a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear and complete botanical description of the plant and the

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characteristics which define same per se and which distinguish the plant from related known cultivars and antecedents.

More specifically:

- A. The disclosure is objected to under 37 CFR 1.121(e) because the Latin name of the genus and species of the plant claimed should be preceded by the heading set forth in 37 CFR 1.163(c) (4).

B. On page 2, lines 18-19, the terms "Large" and "Vigorous" is vague and insufficient in describing the size and vigor of the tree. Additional information should be imported into the specification relative to characteristic and observed height and spread for the observed tree and amount of growth over a specified period of time. Correction is needed.

C. On page 3, line 1, the term "Medium" is vague and insufficient in describing the trunk of the observed tree. Applicant should disclose in the specification the observed trunk diameter (usually measured at a given height above soil level).

D. On page 3, line 5, the "Medium" does not describe the size of the observed tree's branches. Applicant should set forth a more detailed botanical description relative to branch size (diameter) and color.

E. On page 3, line 6, "Medium number" is vague and insufficient in describing the number of lenticels. Applicant should disclose the size, color, average number of lenticels the branch contains.

F. On page 3, line 11, Applicant should provide useful information regarding the shape (form) of the leaf by utilizing appropriate descriptive terms such as --oval-- or --elliptic--. The recitation "Pointed" is vague and insufficient. Correction is needed.

- G. On page 3, line 15, the margin appears to be --crenulate-- and not "Crenate" as the Applicant states. Correction is needed.

H. Applicant should disclose the leaf arrangement, vein color and venation pattern of the observed leaf.

I. Applicant should disclose the petiole length and color of the observed leaf.

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J. Applicant should disclose the number of glands of the observed leaf.

K. In the interest of providing as complete a botanical description of the observed plant as is reasonably possible Applicant should disclose the length, diameter, color and shape of the observed flower's bud. The terms "Medium to large," "Medium" and "Plump" are vague and insufficient in this regard. Clarification is needed.

L. Applicant should disclose the diameter of the flower. The recitation "Medium to large" is vague and insufficient in describing the flower diameter.

M. Applicant should disclose the margin, shape of the apex and base, texture, color (both surfaces) and number of the petals.

N. Applicant should set forth in the specification a description of the reproductive organs and should disclose such information and describe these structures (sizes, numbers, colors) in the interest of providing as complete a botanical description of the observed plant as is reasonably possible.

O. Applicant should disclose the size (diameter and circumference) of the observed fruit as "Medium" is vague and insufficient in this regard.

• P. On page 5, line 15, it is unclear what Applicant is referring to in the recitation "average 0.5 cm." Could this mean the length or the diameter of the stem. The term "Medium" is vague in this regard. Clarification is needed.

Q. On page 5, line 20, Applicant states the density of pubescence as "Medium" which does not describe the density. Clarification is needed.

R. Applicant should clarify the use of the observed fruit i.e. dessert, canning, etc.

S. On page 6, line 14-16, it is unclear whether the observed fruit or the stone is used for local and export markets and has good storage capabilities. Clarification is needed.

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T. If additional information is available relative to plant/fruit disease resistance/susceptibility, such should be set forth in the specification.

U. Applicant should set forth in the specification the productivity of the fruit i.e. pounds per bushels per acre in the interest of providing as complete a botanical description as is reasonably possible.

V. Applicant should set forth in the specification information describing the kernel of the stone.

• W. The claim in this case is improper. The claim must be to the observed plant as illustrated and described. Applicant should delete "parts" language from the claim. An acceptable claim would be, "A new and distinct plant as herein described and illustrated." Should applicant desire, the present descriptive language could also remain in the claim.

The above listing may not be complete. Applicant should carefully review the disclosure and import into same any corrected or additional information which would aid in botanically identifying and/or distinguishing the cultivar for which United States Plant Patent protection is sought.

Claim Rejection

35 U.S.C. § 112, 1st and 2nd Paragraphs

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for reasons set forth in the Objection to the Disclosure Section above.

Comments

Due to the amount of revision seen necessary in this application, it is suggested that Applicant file a substitute specification, incorporating all additions, deletions and modifications so as to provide the printer a clean copy at the time of allowance. Applicant should specifically authorize cancellation of the present specification to the same.

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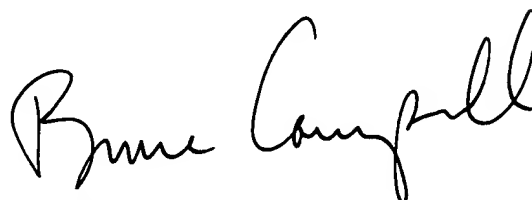
Future Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Susan B. McCormick whose telephone number is (703) 305-1682. The Examiner can normally be reached Monday through Thursday from 7:00 a.m. to 4:30 p.m. and alternate Fridays from 7:00 a.m. to 3:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached on (703) 308-4205. The fax number for the group is (703) 305-3014 or 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Matrix Customer Service Center whose telephone number is (703) 308-0196.

sbm

A handwritten signature in black ink, appearing to read "Bruce Campell", written in a cursive style.

BRUCE R. CAMPPELL, PH.D
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600